

### **REMARKS**

Claims 1-27 are pending. Reconsideration and prompt allowance of the pending claims are respectfully requested.

#### **35 U.S.C. § 103 Rejections**

To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and MPEP § 2143.03.

#### **Claims 22 and 25**

On page 2 the Office Action rejects claims 22 and 25 under 35 U.S.C. § 103 (a) over U.S. Patent 5,588,104 to Lanier et al. (hereafter Lanier I) in view of U.S. Patent 5,446,490 to Blahut et al. (hereafter Blahaut). This rejection is respectfully traversed.

Regarding claim 22, the Office Action asserts that Lanier I teaches all that is claimed except that Lanier I does not teach “the virtual programs are from a television delivery system.” (Emphasis added.) The Office Action then asserts that Blahaut “teaches broadcasting virtual channels from a television delivery system.” The Office Action concludes that “it would have been obvious to the artisan at the time of the invention to include Blahut’s teaching with method of Lanier in order to provide a user with an interactive television system that is ‘transparent’ to unrestricted channels.”

Applicants strongly object to the Office Action’s characterization of Lanier I and Blahut, and the attempt to combine these references to reject claim 22. First, Applicants wonder what possible connection Blahut’s “virtual channels” have to do with the claimed “virtual objects.” Applicants suspect that the Examiner, in a vain attempt to locate a suitable reference to combine with Lanier I, merely searched the patent database for a reference that used the term “virtual.” In fact Blahut’s use of “virtual channels” cannot possibly be combined with Lanier I’s teachings to render claim 22 obvious. That is, a television program delivery system that uses virtual channels does not disclose or suggest that the virtual channels are used to deliver virtual objects. That apparent assumption on the part of the Office Action is simply unsupportable.

Second, the Office Action notes that “Lanier fails to teach the virtual programs are from a television delivery system.” While not agreeing nor disagreeing with this statement, Applicants call the Examiner’s attention to the fact that claim 22 recites virtual objects, not virtual programs.

Third, the Office Action's conclusion that Lanier I and Blahut can be combined to suggest an interactive television system has no relevance to the claimed invention. Lanier I does not teach or suggest delivering virtual objects from a television delivery system, and Blahut does nothing to cure this defect. The fact that the Office Action can imagine some way and some reason to combine these references means nothing if the combination does not teach or suggest all the elements recited in claim 22, and the combination of Lanier I and Blahut most definitely does not teach or suggest all the claimed elements.

Fourth, and finally, Applicants object to the Office Action's characterization of Lanier I as teaching a method of placing virtual objects. Lanier I describes a method and apparatus for creating virtual worlds using a data flow network. The method uses a computer terminal to display the data flow network as a plurality of interconnected units. An interactive program allows the appearance of the plurality of interconnected units to be changed. The data flow network then is automatically altered to correspond with the visual changes. Lanier I's method creates virtual worlds at a user's terminal so that the user may manipulate pictorial objects on a computer screen to effect complicated operations on the virtual world database (see column 1, lines 36-39 of Lanier I). Lanier I does not teach or suggest receiving virtual objects and placing the received virtual objects into virtual object locations.

In contrast to Lanier I and Blahut, claim 22 recites receiving one or more virtual objects, receiving a video program including one or more virtual object locations, and inserting selected virtual objects into the virtual object locations. As noted above, Lanier I and Blahut, individually and in combination, do not disclose or suggest these and other elements of claim 22. Accordingly, claim 22 is patentable.

Claim 25 depends from patentable claim 22, and for this reason and the additional features it recites, claim 25 is also patentable.

Withdrawal of the rejection of claims 22 and 25 under 35 U.S.C. §103 (a) is respectfully requested.

**Claims 1-6, 8-14, 16-21, 23, 24, 26, and 27**

On page 3 the Office Action rejects claims 1-6, 8-14, 16-21, 23, 24, 26, and 27 under 35 U.S.C. § 103 (a) over Lanier I in view of U.S. Patent 5,588,139 to Lanier et al. (hereafter Lanier II) and further in view of Blahut. This rejection is respectfully traversed.

Regarding claim 1, the Office Action asserts that Lanier I teaches the claimed elements except that Lanier I does not teach storing virtual objects in a viewer's terminal. The Office Action then asserts that Lanier II teaches storing the virtual objects in the viewer's terminals, but admits that Lanier I and Lanier II fail to teach that "the virtual programs are

from a television delivery system.” However, the Office Action asserts that Blahut teaches broadcasting virtual channels from a television delivery system, and that “it would have been obvious to the artisan at the time of the invention to include Blahut’s teaching with method of Lanier in order to provide a user with an interactive television system that is ‘transparent’ to unrestricted channels.”

Lanier II is directed to a computer model for generating objects for a multi-person virtual world using data flow networks. Similar to Lanier I, the method and apparatus described in Lanier II are specifically designed for computer terminals. Lanier II actually teaches away from receiving a virtual world from a television delivery system because Lanier II is directed to a simulating method and apparatus that creates a multi-person virtual world on a display terminal using a computer at the user’s site, as evidenced by over seventeen hundred pages of the source listings in the patent. Thus, Lanier II does not teach or suggest virtual objects.

As discussed earlier with respect to the rejection of claim 22, Blahut’s use of virtual channels is not the same as delivering virtual objects from a television delivery system. Since neither Lanier I nor Lanier II teach delivery of virtual objects from a television delivery system, and since Blahut does nothing to cure this defect, the combination of Lanier I, Lanier II and Blahut cannot teach or suggest all the elements of claim 1.

In contrast to the combination of Lanier I, Lanier II and Blahut, claim 1 recites receiving, from a television delivery system, one or more virtual objects for use with one or more virtual object locations, storing the virtual objects in a viewer’s terminal, and inserting one or more of the received virtual objects into one or more of the virtual object locations. As noted above, Lanier I, Lanier II, and Blahut, individually and in combination, do not disclose or suggest all the elements of claim 1. Accordingly, claim 1 is patentable.

Independent claims 9 and 18 both recite elements similar to those in claim 1. For the same reasons as noted above with respect to the rejection of claim 1, these elements of claim 9 and 18 are not taught or suggested by Lanier I, Lanier II, and Blahut, individually and in combination. Accordingly, claims 9 and 18 are also patentable.

Claims 2 – 6 and 8 depend from patentable claim 1, claims 10 – 14, 16, and 17 depend from patentable claim 9, and claims 19 – 21 depend from patentable claim 18. In addition, claims 23, 24, 26, and 27 depend from patentable claim 22. For these reasons and the additional features they recite, claims 2 – 6, 8, 10 – 14, 16, 17, 23, 24, 26, and 27 are also patentable. Withdrawal of the rejection of claims 1-6, 8-14, 16-21, 23, 24, 26, and 27 under 35 U.S.C. 103 (a) is respectfully requested.

**Claims 7 and 16**

On page 9 the Office Action rejects claims 7 and 16 under 35 U.S.C. § 103(a) over Lanier I in view of Lanier II and further in view of U.S. Patent No. 5,737,533 to de Hond. This rejection is respectfully traversed.

Claim 7 depends from patentable claim 1. Claim 16 depends from patentable claim 9. For these reasons and the additional features they recite, claims 7 and 16 are also patentable. De Hond does nothing to alter this conclusion. Withdrawal of the rejection of claims 7 and 16 under 35 U.S.C. §103 (a) is respectfully requested.

**Claim 15**


The Office Action does not include a specific rejection of claim 15, and Applicants note that the applied references, individually and in combination, do not disclose or suggest all the features of claim 15. In addition, claim 15 depends from patentable claim 9. For these reasons, claim 15 is patentable.

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested. Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

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Respectfully submitted,



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